

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

KAIFI LLC,

*Plaintiff,*

v.

T-MOBILE US, INC., T-MOBILE USA,  
INC.,

*Defendants.*

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CIVIL ACTION NO. 2:20-CV-00281-JRG

**ORDER**

The Court held a hearing on several outstanding motions in the above-captioned case filed by Plaintiff Kaifi LLC (“Kaifi”) and Defendants T-Mobile US, Inc. and T-Mobile USA, Inc. (collectively, “T-Mobile”) on Monday, September 27, 2021 (Dkt. No. 297) (the “Hearing”). This Order memorializes the Court’s rulings on the motions addressed during the Hearing as announced from the bench into the record, including additional instructions that were given to the parties. While this Order summarizes the Court’s rulings as announced into the record during the Hearing, this Order in no way limits or constrains such rulings from the bench. Accordingly, it is hereby **ORDERED** as follows:

**1. T-Mobile US, Inc. And T-Mobile USA, Inc.’s Motion to Compel Kaifi to Produce Documents from Prior Litigation of The Patent in Suit (Dkt. No. 100)**

This motion is **GRANTED-IN-PART**. The Court **ORDERED** that the expert infringement reports, the expert damages reports, and the transcripts and exhibits from the deposition of those expert witnesses related to both Kaifi and AT&T Corp. from Case No. 2:19-cv-00138-JRG (E.D. Tex.) be produced from Irell & Manella LLP to Gibson, Dunn & Crutcher

LLP as representatives for the plaintiff and defendant in the above-captioned case, respectively. (*Id.* at 35:23-36:16.)

The Court further **ORDERED** that prior to production, Kaifi's counsel is to review the documents, determine if there is any potential third-party information embedded in them, and upon discovering a reasonable possibility that there is third-party confidential information embedded in the document, give such identified third parties ten (10) days' notice with an opportunity to object prior to at least prior to the production of those portions of the documents. (*Id.*) If there is an objection, then the Court will take it up. If there is no objection, that material is to be produced. (*Id.*)

**2. Kaifi LLC's Opposed Motion To Compel Production Of Documents With Respect To Over-The-Top Services (Dkt. No. 105)**

This motion is **MOOT** in light of the parties' agreement. (Dkt. No. 294 at 5:15-21.)

**3. T-Mobile's Opposed Motion To Compel Kaifi To Produce Documents From Its Parent Entities (Dkt. No. 140)**

This motion was **CARRIED** at the Hearing. (*Id.* at 70:3-19.)

**4. Plaintiff Kaifi LLC's Opposed Motion For Protective Order Re Privileged Communications In AT&T Litigation (Dkt. No. 153)**

This motion was **CARRIED** at the Hearing. (*Id.* at 70:3-19.)

**5. Plaintiff Kaifi LLC's Expedited Motion For Entry Of Order Focusing Patent Claims And Prior Art (Dkt. No. 157)**

This motion is **MOOT** in light of the parties' agreement that T-Mobile will limit its validity challenges to twelve (12) grounds for invalidity (*i.e.*, anticipation, single-reference obviousness, or obviousness combinations) within 30 days of trial. In the event that any of T-Mobile's chosen references are struck by Court order, T-Mobile will be given three (3) days from the Court's order to add additional references. (Dkt. No. 294 5:25-8:9.)

**6. T-Mobile US, Inc. And T-Mobile USA, Inc.’s Motion To Strike Plaintiff’s Late P.R. 3-1(E) Disclosure (Dkt. No. 170)**

This motion was **WITHDRAWN** prior to the Hearing. (*Id.* at 10:14-25.)

**7. Motion by Kaifi To Compel Technical Discovery From Defendants (Dkt. No. 171)**

This motion is **MOOT** in light of the parties’ agreement that T-Mobile will stipulate “that all their OEMs, who provide phones on their network, test those phones to ensure compliance with T-Mobile’s WiFi requirements.” (*Id.* at 8:13-17.) The parties further agreed that Kaifi is to “select five models [of cell phone] that T-Mobile carries for T-Mobile to search for and produce their own WiFi compliance testing materials, and T-Mobile is going to produce, to the extent it’s available, information on data rate [] in the IMS system.” (*Id.* at 8:14-22.)

**8. T-Mobile’s Opposed Motion To Compel The Continued Deposition of Dr. Hanbum Cho (Dkt. No. 172)**

This motion was **WITHDRAWN** prior to the Hearing. (*Id.* at 8:25-9:9.)

**9. T-Mobile’s Opposed Motion To Compel The Production Of Improperly Withheld Documents And The Continued Deposition Of Dr. Hanbum Cho With Respect To Those Documents (Dkt. No. 173)**

This motion was **WITHDRAWN** prior to the Hearing. (*Id.* at 8:25-9:9.)

**10. Motion By Kaifi to Compel Deposition of Kathleen Ham (Dkt. No. 175)**

This motion was **WITHDRAWN** prior to the Hearing. (*Id.* at 8:25-9:9.)

**11. Motion By Kaifi to Damages Related Discovery From Defendants (Dkt. No. 177)**

This motion is **MOOT** in light of the parties’ agreement that T-Mobile will “search for and produce all communications with RPX regarding the Patent-in-Suit after reasonable investigation” and “produce on a [yearly] basis the revenue it generates from its MVNO business.” (*Id.* at. 9:10-10:1.)

**12. Motion By Kaifi to Compel ESI From Defendants (Dkt. No. 178)**

This motion is **MOOT** in light of the parties' agreement that Kaifi would perform the requested search on electronically stored information (ESI) and produce a privilege log. (Id. at 10:3-9.)


**13. T-Mobile US, Inc. And T-Mobile USA, Inc.'s Motion For Leave To File Supplemental Brief In Support Of Its Motion To Compel Kaifi To Produce Documents From Its Parent Entities (Dkt. No. 206)**

This motion is **GRANTED**. (Id. at 16:11-24.)

**14. T-Mobile US, Inc. And T-Mobile USA, Inc.'s Motion For Leave To File Supplemental Brief In Support Of Its Motion To Compel Kaifi To Produce Documents From Prior Litigation Of The Patent In Suit (Dkt. No. 219)**

This motion is **GRANTED**. (Id. at 16:11-24.)

**So ORDERED and SIGNED this 18th day of November, 2021.**

  
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RODNEY GILSTRAP  
UNITED STATES DISTRICT JUDGE